

REMARKS

Claims 48, 49, 52-77 and 79 are pending in the application. By this Amendment, claim is amended to further recite the nature of Applicant's invention. In particular, claim 79 is amended to further recite the interrelationship between the second optimization determination and the first optimization determination.

No new matter is added by this Amendment. Support for the amendments to the claims may be found in the filed patent application in paragraphs 0023, 0041, 0046, and in the drawings, for example, with reference to the published patent application 2002/0116331.

Reconsideration and allowance in view of the following remarks are respectfully requested.

A. The 35 U.S.C. 102 Rejection Based on Johnson

In the Office Action, claims 48, 49, 52-77 and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (hereinafter Johnson) U.S. Patent 6,999,943. This rejection is traversed.¹

Claim 48 recites in particular:

identifying, automatically without human involvement, a payee account based on the payee information;

performing, after identifying the single payment source and the payee account, an **optimization determination** to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in the optimization

¹ As Applicant's remarks with respect to the rejections in the Office Action are sufficient to overcome such rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

determination, **the optimization determination performed automatically without human involvement**; and

(emphasis added)

Claim 48 further recites:

the processor identifying a single payment source includes the processor performing a **second optimization process** to determine the single payment source, the first optimization process being distinct from the second optimization process; and the processor inputs a plurality of selected payment sources, and performs the second optimization determination to determine which one of the selected payment sources is the single payment source.

(emphasis added)

Applicant respectfully submits that Johnson fails to teach or suggest such claimed features.

Under 35 U.S.C. §102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* “A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, **every limitation of the claim.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “The **identical invention** must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). “Absence from the reference of **any** claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

Applicant notes the disclosure of Johnson in columns 9 and 10. In particular, in column 9, lines 43-63, Johnson describes:

Merchant's point-of-sale systems provide information about the transaction methods to transaction evaluator (230) (described in Section E below and elsewhere),

which is responsible for **selecting one of the payment methods**. Both the process of sending information to the transaction evaluator and the transaction evaluator's selection processes are preferably automatic. The selection result typically depends on the estimated cost/benefit characteristics (e.g., economic utility) for each payment method. For example, a payment instrument from an issuer that has a business relationship with the transaction evaluator (which can be operated by the merchant, the issuer, some combination of entities, or independently) to provide a 50-cent rebate per transaction would be chosen over a similar instrument from an issuer that does not. Similarly, a payment method with lower risk or fees (such as cash) could be selected over one with higher fees (such as check). The transaction evaluator can also route transactions that are likely to be unprofitable (e.g., if the transaction is small or has a high credit loss or fraud risk, etc.) away from issuers who have appropriate business relationships with the merchant or the transaction evaluator.

(emphasis added)

Relatedly, in column 19-20, Johnson further describes such processing. In particular, in column

19, line 52 - column 20, line 13, Johnson describes:

In one embodiment of the invention, both (or multiple) issuers of payment instruments receive information about a transaction for which multiple payment methods are available. Each issuer estimates the economic utility then transmits to the transaction evaluator data describing the terms under which they offer to process the transaction. Based on predefined rules, **the transaction evaluator may then either accept an offer, decline all offers, or decide to re-submit the transaction back to the issuers** (e.g., with information concerning the other offers). Each issuer would then have the option to either modify the terms under which they offer to process the transaction or maintain their earlier offer. Thus, the transaction selection process can be performed by conducting an auction among the payment issuers, where the transaction is awarded to the issuer with the most attractive offer (i.e., the offer with the greatest economic utility to the merchant and/or the party operating the transaction evaluator).

(emphasis added)

However, such disclosure of Johnson, as well as the other disclosure of Johnson fails to teach the particulars of claim 48. Claim 48 (as set forth above) specifically recites a first optimization determination and a second optimization determination, including the particulars thereof and the interrelationship therebetween. Johnson fails to teach such features.

In particular, the deficiencies of the rejection are revealed by the proffered analysis as set forth in the Office Action. That is, on page 3, lines 10-22, the Office Action asserts that Johnson teaches:

a processor, the processor communicating with the input portion and the payment platform database so as to input the first information and access select payment platform data, the processor (column 10, lines 32-57 and column 12, lines 1-34);

identifying a single payment source based on the payment source information, the single payment source being the source of funds for the transmission of funds (**column 10, lines 32-57 and column 12, lines 1-34**);

identifying automatically without human involvement a payee account based on the payee information (**column 10, lines 32-57; column 12, lines 1-34 and column 19, lines 21-52 and figures 2 and 3**);

performing, after identifying the single payment source and the payee account, an optimization determination to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in the optimization determination, the optimization determination performed automatically without human involvement (**column 10, lines 32-57; column 12, lines 1-34; column 17, line 65 thru column 18, line 43, and column 19, lines 21-52 and figures 2 and 3**); ...

(emphasis added)

However, as is evidenced by the cites to Johnson (as bolded above), the Office Action relies on the same section (of Johnson) to allegedly teach respective features of the claimed invention.

Accordingly, Applicant respectfully submits that it is inappropriate to rely on the same teachings of Johnson to allegedly teach disparate features of the claimed invention. Relatedly, Applicant submits that such clearly fails to fairly set forth the basis of the rejection. Rather, Applicant respectfully submits that the Office Action appears to pick and choose between disparate teachings of Johnson with the conclusion that such supports the applied 35 U.S.C. 102 rejection. However, Applicant submits that such conclusion is simply not supported.

In a similar manner, the deficiencies of the rejection of claim 79 are revealed on pages 10-11 of the Office Action. Therein, the Office Action asserts that Johnson describes:

performing, after identifying the single payment source and the payee account, a first optimization determination to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in performing the **first optimization determination**, the first optimization determination performed automatically without human involvement (column 10, lines 32-57; column 12, lines 1-34; **column 17, line 65**

thru column 18, line 43, and column 19, lines 21-52 and figures 2 and 3); Examiner notes the system further determines which of several ways to process a transaction based on a cost/benefit analysis. For example it compares processing from a checking account (single source) by either ACH debit versus debit card; see also column 26, lines 55-64);

The Office Action further describes:

the processor identifying a single payment source includes the processor performing a **second optimization determination** to determine the single payment source, the processor inputting a plurality of selected payment sources, and performing the second optimization determination to determine which of the plurality of selected payment sources is to constitute the single payment source, the first optimization process being distinct from the second optimization process, the second optimization determination performed automatically without human involvement (column 10, lines 32-57; column 12, lines 1-34; **column 15, lines 48-51** and column 19, lines 21-52 and figures 2 and 3);

(emphasis added)

Applicant again notes that the Office Action relies on essentially the same disclosure of Johnson to teach both the first optimization determination and the second optimization determination.

Indeed, the only difference in the relied upon teachings of Johnson (as cited in the Office Action) is column 17, line 65 thru column 18, line 43, as well as column 15, lines 48-51. Applicant respectfully submits that a review of such teachings (of Johnson) reveal that such teachings clearly do not support the alleged first optimization determination and the second optimization determination, as alleged in the Office Action.

That is, the disclosure of Johnson at column 17, line 65 thru column 18, line 43, as discussed further below, fails to describe decisioning, but rather simply teaches that different payment processing is available. The disclosure of Johnson at column 15, lines 48-51 merely teaches of communications between the merchant and the customer. Accordingly such fails to describe decisioning, i.e., so as to teach Applicant's claimed invention as recited in claim 48.

In further traversal of the 35 U.S.C. 102 rejection, Applicant notes page 12, lines 11-16.

Therein, the Office Action asserts:

The Examiner respectfully disagrees. Applicant is equating **automatically** as being done by a processor and therefore this is how it is interpreted by the Examiner. Johnson teaches that a processor can identify a single payment source based on payment source information (**column 13, lines 19-20 and column 14, lines 5-9; Examiner notes that the user enters multiple payment method/source, such as credit card or checking account and the transaction evaluator selects a single payment source**). Johnson teaches that the identified single payment source could be a checking account (column 17, line 65 thru column 18, line 14). Johnson also teaches a second optimization that determines a payment mechanism after the payment source. For example, Johnson further teaches that payment from the checking account can be made via ACH transaction or debit card transaction or alternate channel (**column 17, line 65 thru column 18, line 14; Examiner notes that the cost-benefit analysis is performed automatically on different payment mechanisms**). Johnson further teaches that this determination can be performed automatically, using a computer processor in conjunction with the transaction evaluator (column 19, lines 21-52 and Figure 2 and Figure 3).

(emphasis added)

Applicant respectfully submits that such assertions fail to support the rejection. Johnson's teaching of column 17, line 65 thru column 18, line 14 (as relied upon above) does describe that there may be several ways to process a transaction. However, such simply does not describe performing decisioning - so as to determine (either automatically or otherwise) a particular payment mechanism to actually use. Rather, such disclosure of Johnson simply describes that indeed multiple options are available. Relatedly, in the follow-up paragraph (column 18, lines 15-20), Johnson describes

A variety of systems, including those employing neural networks, are used for credit and fraud risk assessment in the credit card industry. Credit card authorization requests are routinely processed by these systems, which evaluate the risk associated with the account and determine whether to accept or decline the transaction.

As should be appreciated, such is fundamentally distinct from Applicant's claimed invention. Such teaching goes to whether a particular transaction should be accepted or declined, and not the decisioning of what payment mechanism should in fact be utilized to perform the transfer of

funds.

For at least the reasons set forth above, Applicant respectfully submits that Johnson fails to teach or suggest each and every feature as recited in claim 48. It is respectfully submitted that claim 48 is allowable at least for the reasons set forth above.

Further, independent claims 73 and 79 recite patentable subject matter at least for reasons similar to those set forth above with respect to claim 48.

The dependent claims recite patentable subject matter based on their dependencies on the respective independent claims, as well as for the additional features such dependent claims recite.

Withdrawal of the 35 U.S.C. §102 rejection is respectfully requested.

B. Conclusion

For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited.

It is believed that no fee is due in connection with this filing. However, if it is determined otherwise, the Commissioner is hereby authorized to charge our Deposit Account No. 50-0206.

Respectfully submitted,

Date:

Aug 4, 2011

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